

REMARKS

Remarks Regarding Amendments:

Claims 1, 3-6 and 20-25 are amended, new claim 26 is added, and claims 10-11 are canceled. The amendments and new claim are fully supported by the original disclosure such as, for example, in original claim 13 and in paragraph [0046]. No new matters are added by these amendments and new claim and their entry is requested.

Remarks Regarding Claim Status:

With the cancellation of claims 10-11, only claims 1, 3-6 and 20-25 are pending and under examination.

Remarks Regarding 102:

A claim is anticipated only if each and every limitation as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is claimed. See *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1, 3-6, 10-11 and 20-25 stand rejected under 35 U.S.C. § 102 as allegedly anticipated by Kaneko (EP 1 146 093) or Barth (US 2002/0090507). Applicants traverse.

Solely in an effort to expedite prosecution, Applicants have amended claim 1 and claims dependent thereon to be product by process claims. Significantly, claim 1 as amended is directed to a hard-coat made by a process that employs hydroxypropyl cellulose – a reagent that is not disclosed explicitly or implicitly by Kaneko or Barth. Since Kaneko or Barth does not disclose a recitation of claim 1, these references cannot anticipate claim 1. Moreover, those claims depending from claim 1 (claims 3-6, 10-11 and 20-25) are also not anticipated by the cited references because the limitations of claim 1 are incorporated in claims depending therefrom. See *In re McCarn*, 101 USPQ 411, 413 (C.C.P.A. 1954).

For the reasons stated above, the withdrawal of the 35 U.S.C. §102 rejection of claims 1, 3-6, 10-11 and 20-25 in view of Kaneko or Barth is requested.

Remarks Regarding 103:

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *In re Kahn*, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) citing *Graham v. John Deere*, 148 USPQ 459 (1966). The *Graham* analysis needs to be made explicitly. *KSR v. Teleflex*, 82 USPQ2d 1385, 1396 (2007). It requires findings of fact and a rational basis for combining the prior art disclosures to produce the claimed invention. See *id.* (“Often, it will be necessary for a court to look to interrelated teachings of multiple patents . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue”). The use of hindsight reasoning is impermissible. See *id.* at 1397 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning”). Thus, a *prima facie* case of obviousness requires “some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct.” *Kahn* at 1335; see *KSR* at 1396.

Claims 1, 3-6, 10-11 and 20-25 stand rejected under 35 U.S.C. § 103 as allegedly obvious in view of Kaneko (EP 1 146 093) or Barth (US 2002/0090507). Applicants traverse.

As discussed above, the claims have been amended to a product by process form. As amended, claims 1, 3-6, 10-11 and 20-25 are directed to, inter alia, hard-coats made with a process involving applying mixtures of materials and nano particles to a substrate, crosslinking of one material, and the removal of at least a part of one component in the mixture of materials. Neither Kaneko or Barth disclosed such a process and, in addition, neither Kaneko or Barth disclose or render obvious a process involving hydroxypropyl cellulose for the production of a hard-coat.

Withdrawal of the Section 103 rejections is requested because the claims would not have been obvious to one of ordinary skill in the art when this invention was made.

Remarks Regarding IDS filed November 28, 2005:

Applicants note that the Examiner has not initialed references EP-A- 1 146 093 and WO-A-01/29148 in form A820 which was submitted as part of an IDS filed on November 28, 2005. The other references on the same form was initialed.

Applicants respectfully request that the Examiner initial the two references (EP-A- 1 146 093 and WO-A-01/29148) in said form A820 submitted November 28, 2005.

Conclusion

Having fully responded to the pending Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if additional information is required.

Respectfully submitted,

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